

ESTTA Tracking number: **ESTTA329142**

Filing date: **01/27/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | FireEye, Inc. |
| Granted to Date of previous extension | 01/27/2010 |
| Address | 1390 McCarthy Blvd. Milpitas, CA 95035 UNITED STATES |
| Correspondence information | FireEye, Inc. 1390 McCarthy Blvd. Milpitas, CA 95035 UNITED STATES jwhite@carrferrell.com,shernandez@carrferrell.com Phone:650-812-3400 |

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 77710534 | Publication date | 09/29/2009 |
| Opposition Filing Date | 01/27/2010 | Opposition Period Ends | 01/27/2010 |
| Applicant | FIREID INTERNATIONAL S.A.R.L. 43 BOULEVARD PRINCE HENRI, L-1724 LUXEMBOURG, LUXEMBOURG | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 009. First Use: 2009/03/05 First Use In Commerce: 2009/03/05 All goods and services in the class are opposed, namely: Computer software for use in the field of encryption and authentication, namely, for generating security passwords which provide verification and authentication of personal identification to computer systems, and authenticating users to computer services, and encrypting transactions |
| Class 042. First Use: 2009/03/05 First Use In Commerce: 2009/03/05 All goods and services in the class are opposed, namely: Consultancy services in the field of computer system security, namely, providing information regarding the encryption and authentication of user, computer and electronic data; data encryption services; computer services, namely, encryption and authentication of data; computer services, namely, providing information concerning the encryption and authentication of electronic data via the Internet and mobile devices |

Grounds for Opposition

| | |
|--------------------------------------|---------------------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | Section 43(a) likelihood of confusion |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3386418 | Application Date | 09/09/2005 |
| Registration Date | 02/19/2008 | Foreign Priority Date | NONE |
| Word Mark | FIREEYE | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 009. First use: First Use: 2007/02/26 First Use In Commerce: 2007/02/26 Computer hardware; computer peripherals; computer software for monitoring, filtering and reporting network traffic; computer software for detecting, reporting, blocking and eliminating viruses, worms, malware, spyware, unauthorized software and network attacks</p> <p>Class 042. First use: First Use: 2007/02/26 First Use In Commerce: 2007/02/26 Technical support services, namely, troubleshooting of computer hardware and software problems</p> | | |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3386626 | Application Date | 02/02/2006 |
| Registration Date | 02/19/2008 | Foreign Priority Date | NONE |
| Word Mark | FIREEYE | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 009. First use: First Use: 2007/02/26 First Use In Commerce: 2007/02/26 Computer hardware; computer peripherals; computer software for monitoring, filtering and reporting network traffic; computer software for detecting, reporting, blocking and eliminating viruses, worms, malware, spyware, unauthorized software and network attacks</p> <p>Class 042. First use: First Use: 2007/02/26 First Use In Commerce: 2007/02/26 Technical support services, namely, troubleshooting of computer hardware and</p> | | |

| | |
|---------------------|---|
| | software problems |
| Related Proceedings | 77/710,511 |
| Attachments | 78710294#TMSN.jpeg (1 page)(bytes) 78805838#TMSN.jpeg (1 page)(bytes) Notice of Opposition (00423882).PDF (7 pages)(28557 bytes) |

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|----------------|
| Signature | /Joi A. White/ |
| Name | FireEye, Inc. |
| Date | 01/27/2010 |

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL
AND APPEAL BOARD**

In the Matter of
Trademark Application Serial No. 77/ 710,534
Published: September 29, 2009
Mark: FIREID
Opposed Classes: 9, 42

| | | |
|-------------------------------|---|----------------------|
| FireEye, Inc. |) | |
| |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No. _____ |
| |) | |
| FIREID INTERNATIONAL S.A.R.L. |) | |
| |) | |
| Applicant. |) | |
| |) | |

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Sir:

Opposer FireEye, Inc., a Delaware corporation having its principal place of business at 1390 McCarthy Blvd., Milpitas, California 95035, believes it will be damaged by registration of the mark shown in Application Serial Number 77/ 710,534 (“Applicant’s Mark”).

Opposer was granted an extension of time up to and including January 27, 2010, within which to file this Notice of Opposition. Opposer hereby opposes Applicant's application for FIREID with respect to the goods in Class 9 and the services in Class 42, alleging as grounds for its opposition that:

1. As is evidenced by the publication of Applicant's Mark in the September 29, 2009 issue of the Official Gazette, Applicant FIREID INTERNATIONAL S.A.R.L. seeks to register FIREID in Class 9 in connection with computer and data security software for "verification and authentication of personal identification to computer systems" and for "authenticating users to computer services, and encrypting transactions".

2. As is evidenced by the publication of Applicant's Mark in the September 29, 2009 issue of the Official Gazette, Applicant seeks to register FIREID in Class 42 in connection with "computer system security" consulting services, "data encryption services," and providing information concerning data encryption and authentication services.

3. Opposer FireEye, Inc. has used its FIREEYE mark in connection with computer and data security hardware, software and services, for, among other things, verification of computer systems for access to computer networks, and ensuring computer services, data and encrypted transactions are not bound for unauthorized destinations. Opposer has also used its mark in connection with computer system security consulting services and providing information about computer system security. Opposer has used FIREEYE in advertising and on the internet since at least as early as May 1, 2006. The FIREEYE mark has been used in interstate commerce since at least as early as February 26, 2007, and the mark has been used continuously since that time. Opposer's common law trademark rights pre-date the April 9, 2009 filing date of Applicant's Mark and the Applicant's date of first use of March 5, 2009, claimed in Application Serial Number 77/ 710,534. Opposer's FIREEYE mark has become well-

known as identifying Opposer's goods and services and, as a result, has become a valuable asset of Opposer and the principal symbol of its goodwill.

4. Opposer FireEye, Inc. has registered its FIREEYE mark in the U.S. Patent and Trademark Office and owns U.S. Registration No. 3,386,418 for FIREEYE in plain text "standard characters", filed with the U.S. Patent and Trademark Office on September 9, 2005, claiming a date of first use at least as early as February 26, 2007, for use in connection with "Computer hardware; computer peripherals; computer software for monitoring, filtering and reporting network traffic; computer software for detecting, reporting, blocking and eliminating viruses, worms, malware, spyware, unauthorized software and network attacks in Class 9" and "Technical support services, namely, troubleshooting of computer hardware and software problems" in Class 42. Said registration is valid and subsisting, not abandoned, and in good standing. Said registration evidences Opposer's exclusive right to use FIREEYE in connection with said goods and services. Opposer's constructive use date of September 9, 2005 pre-dates the April 9, 2009 filing date of Applicant's Mark and the Applicant's date of first use of March 5, 2009, claimed in Application Serial Number 77/ 710,534.

5. Opposer FireEye, Inc. has registered its FIREEYE (& Design) mark , depicting flames over an eye and the word FIREEYE, and owns U.S. Registration No. 3,386,626, filed with the U.S. Patent and Trademark Office on February 2, 2006, claiming a date of first use at least as early as February 26, 2007, for use in connection with "Computer hardware; computer peripherals; computer software for monitoring, filtering and reporting network traffic; computer software for detecting, reporting, blocking and eliminating viruses, worms, malware, spyware, unauthorized software and network attacks" in Class 9 and "Technical support services, namely, troubleshooting of computer hardware and software problems" in Class 42. Said registration is valid and subsisting, not abandoned, and in good standing. Said registration evidences Opposer's exclusive right to use its Logo, FIREEYE (& Design), in

connection with said goods and services. Opposer's constructive use date of February 2, 2006, pre-dates the April 9, 2009 filing date of Applicant's Mark and the Applicant's date of first use of March 5, 2009, claimed in Application Serial Number 77/ 710,534.

6. Applicant mark, FIREID, is identical to Registrant's in the first two syllables: "FIRE and I". Applicant's mark, FIREID, is aurally identical to Opposer mark, FIREEYE, but for one syllable: "D". Registrant's mark is heard in its entirety in the Applicant's mark.

7. Applicant's mark, FIREID, is identical in the appearance of the first half of the mark, as both contain the word FIRE.

8. In view of the aural and visual similarities of Opposer's and Applicant's respective marks and the related nature of the parties' goods and services, it is alleged that Applicant's Mark so resembles Opposer's FIREEYE mark and FIREEYE (& Design) mark as to be likely to cause confusion or mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained, that Applicant's Trademark Application Serial Number 77/ 710,534 be rejected, and that Applicant be denied registration of FIREID for the goods in Class 9 and the services in Class 42, as specified in said application.

Please address all correspondence regarding this matter to
Ji A. White, Carr & Ferrell LLP, 2200 Geng Road, Palo Alto, California, 94303.

The required fee under 37 C.F.R. §2.6(a)(17) of \$600.00 is being submitted with this electronic filing. Should any additional fees be required, please charge such

necessary fees to our Deposit Account No. 50-3937.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ji A. White". The signature is fluid and cursive, with the first name "Ji" being more prominent.

Dated: January 27, 2010

Ji A. White, Esq.
Jefferson F. Scher, Esq.
CARR & FERRELL LLP
2200 Geng Road
Palo Alto, California 94303
Phone: (650) 812-3400
Fax: (650) 812-3444

PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Santa Clara, California.

I am over the age of eighteen years and not a party to the within cause; my business address is 2200 Geng Road, Palo Alto, California 94303. On January 27, 2010, I served the within NOTICE OF OPPOSITION on the interested party in said cause, by placing a true copy thereof enclosed in a sealed envelope and placing the envelope for collection and mailing at the above address, following ordinary business practices, addressed as follows:

Stacey Hallerman
Richemont North America
Fifth Floor
645 Fifth Avenue
New York NY 10022
Michael Chiappetta
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017

John P. Margiotta
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017

I am readily familiar with this business' practice for collection and processing of correspondence for mailing with the U.S. Postal Service. This correspondence would be deposited with the U.S. Postal Service this same day in the ordinary course of business.

I declare under penalty of perjury that the foregoing is true and correct,
and that this declaration was executed at Palo Alto, California, this 27th day of
January, 2010.

A handwritten signature in black ink, appearing to read "Ji A. White". The signature is fluid and cursive, with the first name "Ji" and last name "White" clearly distinguishable.

Ji A. White